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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,753	12/19/2001	Jayarama K. Shetty	GC695	2084

7590 05/26/2005

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EXAMINER

PRATS, FRANCISCO CHANDLER

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,753

Applicant(s)

SHETTY ET AL.

Examiner

Francisco C. Prats

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-18,21-34,37-51 and 53-61 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 2, 6-18, 21-34, 37-51 and 53-61 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Art Unit: 1651

DETAILED ACTION

The amendment filed March 22, 2005, has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

Claims 1, 2, 6-18, 21-34, 37-51 and 53-61 are pending and are examined on the merits.

Claim Rejections - 35 USC § 102/103

Claims 46-51 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Antrim et al (U.S. Pat. 5,322,778).

The reference discloses a liquefied starch product which appears to be identical to the presently claimed product, based on the fact that the prior art product is a starch liquefact having a DE of 10.05, which is within the range recited in the claims, and a pH of 4.50, within the range recited in the claims, and being produced by an enzyme having essentially the same hydrolytic properties as the enzyme recited in the claims. See, column 7, lines 1-42. It is noted that the claims require the DE of about 10-12 to be reached within 60-75 minutes of adding the amylase. However, the fact remains that the claims recite a product made by contacting the same starting material as the prior art, under the same conditions as in the prior art,

Art Unit: 1651

with the same enzyme as the prior art. Consequently, even if the process results in the desired product more quickly, the claimed liquefied starch product still appears to be anticipated by the reference.

It is noted that the enzyme used to produce the claimed product is from a different species of microorganism than the prior art enzyme. However, even if this results in a nominal difference between the reference product and the claimed product such that there is, in fact, no anticipation, the reference product would, nevertheless, have rendered the claimed product obvious to one of ordinary skill in the art at the time the claimed invention was made in view of the fact that one of ordinary skill would have expected nominal differences between starch liquefact products based on normal process variations between different hydrolysis batches and differences in enzyme batches. Thus the claimed invention as a whole was clearly *prima facie* obvious especially in the absence of sufficient, clear, and convincing evidence to the contrary.

Regarding the propriety of this type of alternative rejection, note that MPEP 2113 states that:

. . . [w]hen the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is

Art Unit: 1651

eminently fair and acceptable. As a practical matter, the Patent and Trademark Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith. *In re Brown*, 59 CCPA 1063, 173 USPQ 685 (1972).

MPEP 2113 also clearly states that

The Patent Office bears a lesser burden of proof in making out a case of *prima facie* obviousness for product-by-process claims because of their peculiar nature than when a product is claimed in the conventional fashion. *In re Fessmann*, 180 USPQ 324 (CCPA 1974)."

All of applicant's argument regarding this ground of rejection has been fully considered but is not persuasive of error. Applicant urges that the claimed process does not require the use of bisulfite, as used in Antrim. Applicant also urges that Antrim performs a pH readjustment step, also not required in the claimed process. However, neither of these arguments demonstrates that Antrim's product is any different than that recited in the claims. On the current record, the prior art product has the same degree of hydrolysis as the product recited in product-by-process claims 46-51, the same pH as the product recited in product-by-process claims 46-51, and is produced by an enzyme having the same hydrolytic activity as the product recited in product-by-process claims 46-51. In the MPEP-mandated practice for prosecuting product-by-process claims, as set forth above, applicant bears the burden of

Art Unit: 1651

demonstrating that the claimed product differs from the prior art product. Applicant has failed to demonstrate that any of the claimed process steps imparts a difference between the claimed product and Antrim's product. The rejection is therefore maintained.

Claim Rejections - 35 USC § 103

Claims 1, 2, 6-18, 21-34, 37-51 and 53-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shetty et al ("Factors Affecting the Economics of Glucose Production," Delivering Innovation Through Biotechnology, Genencor International, Inc., (1998)) in view of JP 10-136979.

Shetty discloses a process of preparing glucose from starch, said process using the claimed process parameters. See, e.g. pages 6 and 14. Note in particular the disclosure on page 6 of the desirability of a liquefact having a DE of 10 to 12. Shetty differs from the claims in that Shetty uses a different α -amylase enzyme than that recited in the claims. However, Shetty discloses that α -amylases active at acidic pH are advantageous in processes of producing glucose from starch. Specifically, the liquefaction step is improved by decreasing chemical demand for pH adjustment, reducing color and by-product formation, and lowering refining requirements and costs (Shetty,

Art Unit: 1651

page 7). Also, the lower pH afforded by the use of acidophilic α -amylase eliminates the undesirable formation of maltulose (Shetty, page 8). Shetty also discloses that enzymes which do not require calcium or stability are advantageous, as are relatively thermostable enzymes. Shetty, page 11, last sentence. ("It is evident from the above data that an improved thermostable alpha-amylase which can operate at a pH below 6.0 and at lower or no calcium will significantly reduce refining costs and improve the final glucose yield.")

As is evident from the English translation supplied herewith, JP '979 discloses an α -amylase which meets exactly the criteria disclosed by Shetty as being desirable and advantageous for use in the disclosed process of preparing glucose from starch. Specifically, the enzyme is thermostable, acid-stable, optimally active at a pH of about 4, and does not require calcium for activity (see Table 2). Thus, the artisan of ordinary skill practicing Shetty's process clearly would have recognized that the enzyme disclosed by JP '979 possesses all the properties required for use in Shetty's process. The artisan of ordinary skill would therefore clearly have been motivated to have used the enzyme of JP '979 in Shetty's process. A holding of obviousness is therefore required.

Art Unit: 1651

Because it is not clear that the enzyme units used in JP '979 correspond to the units used in applicant's claims, it is not clear that either reference discloses the use of the claimed amount of amylase. However, the artisan of ordinary skill at the time of applicant's invention clearly would have recognized that the rate of the liquefaction would have been readily optimized, depending on the amount of enzyme used. Thus, the claimed amounts of enzyme must be considered obvious in view of the fact that enzyme concentration was known to be a result-effective parameter, and therefore routinely optimized by artisan of ordinary at the time of applicant's invention.

Lastly, it is again noted that the claims require the DE of about 10-12 to be reached within 60-75 minutes of adding the amylase. However, it is respectfully submitted that this limitation does not serve to distinguish the claims from the cited prior art. Specifically, it is noted that at 75 minutes the DE of the various liquefaction processes disclosed by Shetty is about 9, which is encompassed by the lower limit of the presently claimed DE range of "about 10-12." See page 14 of Shetty, especially figs. 2 and 3. Moreover, the speed of an enzymatic reaction can be increased simply by increasing the ratio of enzyme to substrate, that is, by increasing the amount of enzyme or decreasing the amount of substrate. Thus, viewing

Art Unit: 1651

the cited prior art, it is respectfully submitted that the artisan of ordinary skill had a reasonable expectation that the claimed DE could be reached in the claimed amount of time by following the teachings of Shetty and JP '979. A holding of obviousness is therefore required.

All of applicant's argument regarding this ground of rejection has been fully considered but is not persuasive of error. Applicant urges that the asserted combination of references does not render the claims obvious because, contrary to the claimed processes, the JP '979 discloses that the liquefaction medium must be adjusted to pH 4.5 before liquefaction can be performed using the enzyme disclosed therein. Applicant cites paragraph [0063] (actually paragraph [0061], Example 3) in support of this assertion. Thus, urges applicant, because the '979 process requires pH adjustment, and the claimed process does not, JP '979 cannot render obvious the claimed subject matter wherein pH adjustment is not required.

Applicant's argument ignores the fact that the rejection of record is made under § 103(a) and is based on a combination of two references, Shetty and JP '979. Shetty clearly discloses that refined starch from the wet milling of grain enters the liquefaction process at pH 4.0 to 5.0. See Shetty at page 7. Shetty also discloses that liquefaction at that pH range would

Art Unit: 1651

be advantageous because it would reduce the chemical demand for pH adjusting agents. See, *id.* Thus, by using the JP '979 enzyme in the liquefaction process of Shetty, one would not need to adjust the pH. Avoidance of the pH adjustment step is clearly described by Shetty as being advantageous. Moreover, the artisan of ordinary skill would have been motivated to have used the JP '979 enzyme in Shetty's pH 4.0 to 5.0 liquefaction process, since Shetty's preferred pH range is the exact pH optimum of the JP '979 enzyme. Therefore, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Lastly, as to asserted advantage with respect to the speed of the reaction recited in the claims, it is again noted that reaction rate can be increased by increasing the enzyme to substrate ratio.

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS**

Art Unit: 1651

ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

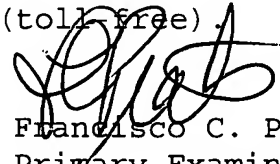
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francisco C. Prats whose telephone number is 571-272-0921. The examiner can normally be reached on Monday through Friday, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the

Art Unit: 1651

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Francisco C. Prats
Primary Examiner
Art Unit 1651

FCP